

Appl. No. 10/840,133
Resp. Dated January 16, 2006
Reply to Office Action of September 16, 2005

Atty. Docket No. 5005.1078

Amendments to the Drawings:

The attached drawing sheet includes changes to Fig. 1. The sheet with changes to Fig. 1 replaces the original sheet including Figs. 1 and 2.

Attachment: One (1) Replacement Sheet.

REMARKS

Claims 1-11 are pending in the present application. The disclosure was objected to due to informalities. The specification was objected to a failing to provide proper antecedent basis for the claimed subject matter. Claims 9-11 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite. Claims 1 and 8 were objected to due to informalities. Claims 1-11 were rejected under 35 U.S.C. §103(a) as being unpatentable over Takabayashi et al. (EP 510 329) in view of Aono (Japanese reference No. 2001-91822).

Claims 1 and 8-11 have been amended. The specification and the drawings have been amended. Reconsideration of the application is respectfully requested.

Consideration of information disclosure statement

In the copies of the PTO Form 1449s attached to the Office Action and associated with information disclosure statements respectively filed by applicants on May 6, 2004 and September 28, 2004, the Examiner has not considered the non-English language references AJ, AK, and A11. Applicants submitted, with the respective information disclosure statements, English language abstracts for the AK and A11 references, and a corresponding U.S. patent for the AJ reference. It is respectfully submitted that submission of an English language abstract of a reference or a corresponding English language patent may fulfill the requirement for concise statement of the relevance of each reference not in the English language. See MPEP §609 III A (3).

Consideration of the cited references and initialing of the respective Form PTO-1449s is respectfully requested.

Objections to the disclosure and specification

The disclosure was objected to due to informalities. The specification at paragraphs [0016] and [0017] has now been amended to provide proper descriptions for Figs. 3 and 4, respectively, that match the detailed descriptions provided in paragraphs [0020] and [0026], respectively.

The specification was objected to a failing to provide proper antecedent basis for the claimed subject matter. The specification at paragraph [0018] has now been amended to provide support for the arrangement of the analyzer and glass wedge plates being arranged on a common mount, as recited in claim 4. Fig. 1 has also been accordingly amended to show reference number 40 for the common mount. The amended Fig. 1 is submitted herewith for the Examiner's consideration.

Withdrawal of the objections to the disclosure and the specification, is respectfully requested.

Rejection under 35 U.S.C. §112, second paragraph

Claims 9-11 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite. Claims 9-11 have now been amended to properly depend from independent claim 8.

Withdrawal of the rejection of claims 9-11 under 35 U.S.C. §112, second paragraph, is respectfully requested.

Objection to claims 1 and 8 due to informalities

Claims 1 and 8 were objected to due to informalities. Claims 1 and 8 have now been amended to clarify that a first glass wedge plate and a second glass wedge plate are recited.

Withdrawal of the objection to claims 1 and 8 due to informalities is respectfully requested.

Rejection under 35 U.S.C. §103(a)

Claims 1-11 were rejected under 35 U.S.C. §103(a) as being unpatentable over Takabayashi et al. (EP 510 329) in view of Aono (Japanese reference No. 2001-91822). It is noted that the Office Action apparently refers to columns of Aono, U.S. Patent No. 6,674,574, (hereafter "Aono U.S.") corresponding to the Japanese Aono reference.

Takabayashi et al. describes a photographing apparatus for microscopes for

simultaneous observation and overlapping of images achieved by different microscopy methods. See Abstract. A differential interference contrast prism 38 is arranged in front of an analyzer 39. See col. 9, lines 5-10, and Fig. 4.

Aono describes a focusing system for a microscope using an optical path correction unit 42 in which a parallel prism 43 formed by a stack of wedge prisms 43a, b can be moved so as to change the proportion of the thickness of wedge prism 43a to that of wedge prism 43b. See Aono U.S., col. 8, lines 31-41, and Fig. 7.

Independent claims 1 and 8 of the present application, as amended, respectively recite “a first glass wedge plate and a second glass wedge plate disposed” (claim 1) and “disposing a first glass wedge plate and a second glass wedge plate” (claim 8) “behind the analyzer in an imaging direction” “so as to compensate to zero for the beam deflection caused by the analyzer.” It is respectfully submitted that it is not proper to combine Takabayashi et al. and Aono to purportedly arrive at the invention recited in claims 1 and 8. Moreover, it is respectfully submitted that even if such a combination were to be made, the combination would not teach or suggest all the features of claims 1 and 8. Making the combination is not proper because there would have been no suggestion or motivation to modify Takabayashi et al. to provide two wedge-shaped plates disposed after an analyzer for the purpose of compensating for a change in beam deflection caused by the analyzer. Takabayashi et al. has nothing to do with, and does not even mention, the problem of image offset. The system of Takabayashi et al. might not have an image offset problem at all. The construction of analyzer 39 of Takabayashi et al. is not described. Other analyzer materials besides a polarizing film, which causes deflection of the incident light and image shift (see present specification at paragraph [0007]), are known. Such other analyzer materials may not cause the image shift problem addressed by the present invention. There would have been no suggestion or motivation to look to Aono to solve a problem not even recognized in Takabayashi et al. Nor has a suggestion or motivation on any other basis been demonstrated.

Irrespective of the propriety, or not, of combining Aono with Takabayashi et al., it is respectfully submitted that such a combination would not teach or suggest all the features of

claims 1 and 8. Specifically, such a combination would not teach or suggest disposing a first glass wedge plate and a second glass wedge plate behind the analyzer in an imaging direction so as to compensate to zero for the beam deflection caused by the analyzer, as recited in claims 1 and 8. Indeed, neither of the references teaches or suggests these features. In contrast, Takabayashi et al. merely describes a differential interference contrast prism 38 is arranged in front of an analyzer 39. See Takabayashi et al., col. 9, lines 5-10, and Fig. 4. And Aono merely describes correcting an optical path length for focusing a microscope, by moving a stack of wedge prisms, and moving certain wedge prisms for such path length compensation in a way to avoid a lateral image shift due to the wedge prisms themselves. See Aono U.S., col. 8, lines 31-41, col. 11, lines 10-20, and Fig. 7. Image offset due to an analyzer, much less compensation of such an image offset, is nowhere mentioned in Aono. Moreover, claims 1 and 8 specifically recite that the glass wedge plates are disposed behind the analyzer so as to compensate to zero for the beam deflection caused by the analyzer. Aono moves wedge prisms so as to correct an optical path length, in a way so as to avoid a lateral image shift due to the prisms. Aono nowhere teaches or suggests disposing the prisms so as to compensate to zero for a beam deflection caused by the analyzer, as recited in claims 1 and 8. The placement or movement of the wedge prisms according to Aono would not necessarily dispose the prisms so as to compensate to zero for a beam deflection caused by the analyzer, as recited. Because both Takabayashi et al. and Aono fail to teach or suggest at least the above-recited features of independent claims 1 and 8, a combination of these two references, even if proper, could not render claims 1 and 8 or their respective dependent claims unpatentable.

Withdrawal of the rejection of claims 1-11 under 35 U.S.C. §103(a) based on Takabayashi et al. in view of Aono is respectfully requested.

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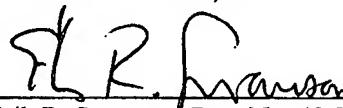
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CONCLUSION

It is respectfully submitted that the application is now in condition for allowance.

Respectfully submitted,

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